

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES
Attorney Docket No.: 14283US02**

In the Application of:

Jeyhan Karaoguz, et al.

Electronically Filed On April 5, 2011

Serial No.: 10/667,829

Filed: September 22, 2003

For: MEDIA PROCESSING SYSTEM
SUPPORTING USER CAPTURED
MEDIA DISPLAY SEQUENCING
WHEN IN IDLE STATE

Examiner: Schnurr, John R.

Group Art Unit: 2421

Confirmation No.: 1006

REPLY BRIEF

Mail Stop Appeal Brief – Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

The Applicants respectfully request that the Board of Patent Appeals and Interferences reverse the final rejection of claims 1-12, 14-26, 28-32, and 34-48 of the present application for at least the reasons set forth in the Appeal Brief and this Reply Brief. This Paper is timely because it is being filed within two months of the March 1, 2011 mailing date of the Examiner's Answer.

REMARKS

The Applicants note that the Examiner's Answer provides essentially the exact same arguments and reasoning as the Final Office Action. *Compare* Examiner's Answer at pages 3-13 with April 27, 2010 Office Action at pages 2-12. The Applicants address these arguments in the Appeal Brief at pages 8-29. To the extent that the Examiner's Answer raises new issues or arguments, the Applicants will address below.

The Examiner's Answer continues to insist that Ten Kate discloses "storing idle state media at a first location and a user interface for identifying the particular media as user scheduled or idle state, wherein the user interface is used to choose when idle state media is displayed." *See* Examiner's Answer at page 13. The Applicants explain why this assertion is in clear error. *See* Appeal Brief at, for example, pages 10-12.

The Examiner's Answer cites Ten Kate at column 4, line 64 to column 5, line 7 and column 6, lines 12-13 and 20-28 as disclosing a "user interface for identifying particular media as one of the idle state media or the user scheduled media [stored at the first location], ... wherein the user interface is used to choose when the idle state media is displayed," as recited in claim 1. *See* Examiner's Answer at page 13.

However, Ten Kate merely discloses that a "user [is allowed] to select programs to be viewed, recorded or reminded of." *See* Ten Kate at column 4, lines 64-65. Further, a virtual channel module 15 is capable of creating one or more virtual channels, featuring said selected programs stored in the memory 11." *See id.* at column 4, line 67 to column 5, line 2. Moreover, a "user profile may be specified by means of habit watching or explicit user input." *See id.* at column 6, lines 12-13.

Thus, in Ten Kate, a user is able to select programs to be viewed, recorded or reminded of, and a user profile may be determined through user habits.

Again, though, Ten Kate discloses a system in which a user identifies particular programs for a virtual channel. However, these programs are shown on genuine channels, but are not

stored entirely at the user's location.¹ Moreover, the user does not schedule the times of **these programs**. Instead, the times are dictated by the "genuine channels." The "apparatus takes care of **automatically switching between the genuine channels broadcasting** the programs viewed on the virtual channel." *See id.* at Abstract. Thus, in Ten Kate, the user does not **schedule any** stored media according to a time schedule.

As noted above, the Examiner's Answer also specifically relies on Ten Kate at column 6, lines 20-28. *See* Examiner's Answer at page 13. However, this portion of Ten Kate states the following:

The scheduler module 16 further maintains a database of information about the programs available on the video recorder 17, e.g. their title, duration and program category. If a gap is encountered in the schedule of the virtual channel, **the scheduler module 16 searches the database for recorded programs having a length which is substantially equally to the length of the gap.** If such programs are found [by the scheduler module 16], one of them is scheduled for the virtual channel to fill the gap. Alternatively, various shorter recorded programs are combined to fill the gap, or a longer recorded program is split in several parts, each filling a different gap in the schedule of the virtual channel, e.g., before and after a new bulletin.

See id. at column 6, lines 20-29 (emphasis added). Notably, Ten Kate is clear that the scheduler module 16, **not a user**, searches for and selects a recorded program having a length that is substantially the same as a gap.

Ten Kate does not describe, teach, or suggest "a user interface for identifying particular media as one of the idle state media, wherein the user interface is used to choose when the idle state media is displayed," as recited in claim 1, "**selecting particular user stored media as one of idle state media** or user scheduled media **based upon input from a user at a first location**," as recited in claim 10, or "selecting the media stored at the first location as idle state media or user scheduled media based upon input from a user," as recited in claim 21. *See* Appeal Brief at

¹ The Office Action and Examiner's Answer acknowledge that Ten Kate does not describe, teach, or suggest "storing all of the user scheduled media at the first location, wherein the user scheduled media includes selected stored media arranged according to broadcast times." *See* Examiner's Answer at page 4.

pages 9-12, 15-17, and 20-22. Thus, for at least these reasons, the Examiner's Answer, much like the Office Action, fails to establish a *prima facie* case of unpatentability with respect to claims 1, 10, 21, and the claims depending therefrom.

Additionally, claim 1 recites, in part, “**displaying, from the storage at the first location,** of idle state media when no user scheduled media is available on the television display **at the first location and the at least one display device at the second location.**” The claim is clear that the idle state media stored at the first location is displayed at first **and** second locations. The Applicants explain that the Office Action fails to demonstrate that any of the cited references describe, teach, or suggest these limitations. *See* Appeal Brief at pages 12-13, 17-18, 23, and 26.

However, the Examiner's Answer continues to rely on Hamano as disclosing idle state media stored at a first location being displayed at the first location and the second location. *See* Examiner's Answer at pages 13-14. In particular, the Examiner's Answer cites Hamano at [0037], [0038], and [0044].

Hamano, however, only discloses advertisements displayed on a remote display. *See* Hamano at [0037]. In particular, Hamano discloses a set top box that “transmits the advertising information that has been targeted to the user to the remote display terminal via wireless transmission.” *See id.* at [0044]. Similar to Ten Kate and Wood, however, Hamano does not describe, teach or suggest displaying information stored at a first location on a display at the first location **and** a display at the second location. Instead, similar to Ten Kate and Wood, Hamano only discloses display at one location.

None of Ten Kate, Wood or Hamano describes, teaches or suggests “the set top box circuitry at the first location causing the displaying, from the storage at the first location, of idle state media when no user scheduled media is available on the television display at the first location **and the at least one display device at the second location,**” as recited in claim 1, “causing the displaying of the idle state media through set top box circuitry **at the first location and a second location** according to a user defined sequence, if no user scheduled media is available,” as recited in claim 10, “causing the displaying of the idle state media through set top box circuitry at the first location and a second location according to a user defined sequence, when no user scheduled media is available,” as recited in claim 21, and “causing the displaying at

the first location and a second location, from the storage at the first location, of idle state media when no user scheduled media is available,” as recited in claim 29. Thus, for at least these reasons, the Examiner’s Answer has failed to establish a *prima facie* case of unpatentability with respect these claims and the claims depending therefrom.

Claim 1 also recites, in part, “storage at the first location for storing **all idle state media and all user scheduled media [that is displayed at **both** the first and second locations].” The Examiner’s Answer, much like the Office Action, has not shown that any of the cited references describes, teaches, or suggests a storage at one location for storing **all idle state media and all user scheduled media [that is displayed at **both** the first and second locations],” as recited in claim 1, for example. Claims 10, 21, and 29 recite similar limitations. Thus, for at least these reasons, the Examiner’s Answer has not established a *prima facie* case of unpatentability with respect to these claims or the claims depending therefrom.****

Additionally, in the Appeal Brief, the Applicants requested the following:

If the current rejection is maintained, the Applicants respectfully request that the Examiner’s Answer: 1) **identify the specific Rationale** (i.e., by specifically indicating one of **A through G** noted above) in the Guidelines that the Examiner is using to support the obviousness rejection so that the Applicants may more clearly address the Examiner’s concerns, and 2) **state on the record the required** factual findings to support the Rationale that the Examiner has chosen. Failure to specifically identify the specific rationale and state the required factual findings will seemingly be a tacit admission that the Examiner is unable to satisfy the **required** factual findings.

See Appeal Brief at pages 14, 19, 24-25, and 28.

Instead of specifically indicating one of A through G as requested by the Applicants, the Examiner’s Answer states the following:

In response to appellant’s request for the examiner to identify the specific rationales supporting the conclusion of obviousness, the examiner notes that the rationales and the factual findings supporting each rational [sic] are articulated in the detailed rejections of the claims. Specifically, the combinations of Ten Kate, Wood, Haman and Matz are supported by a teaching, suggestion or motivation in the prior art that would have led one of ordinary skill in the art at the time the invention was made to

modify the prior art teachings to arrive at the claimed invention. Specific citations of support for the motivation can be found through the rejection indicating paragraphs [0010] of Wood and [0037] of Hamano.

See Examiner's Answer at page 14.

Thus, the Examiner is utilizing Rationale G of the PTO's Obviousness Guidelines.

As the PTO mandates, however, "[i]t is important for Office personnel to recognize that when they do choose to formulate an obviousness rejection using one of the rationales suggested by the Supreme Court in *KSR* and discussed in the 2007 *KSR Guidelines*, they are to adhere to the instructions provided in the MPEP regarding the necessary factual findings." See "Examination Guidelines Update: Developments in the Obviousness Inquiry After *KSR* v Teleflex," Federal Register, Vol. 75, No., 169 (September 1, 2010) (emphasis added). "It remains Office policy that appropriate factual findings are **required** in order to apply the enumerated rationales properly. If a rejection has been made that omits one of the required factual findings, and in response to the rejection a practitioner or inventor points out the omission, Office personnel **must** either withdraw the rejection, or repeat the rejection including all required factual findings." See *id.* (emphasis added).

With that in mind, the Guidelines state the following with respect to Rationale G:

To reject a claim based on this rationale, Office personnel **must** resolve the *Graham* factual inquiries. Then, Office personnel **must** articulate the following:

... a finding that there was a reasonable expectation of success; ...

See MPEP §2143(G).

With respect to the *Graham* factual inquiries, the Office Action does not attempt to "resolv[e] the level of ordinary skill in the pertinent art." Instead, the Examiner's Answer simply summarily concludes that "it would have been obvious to one with ordinary skill in the art." See Examiner's Answer at pages 4-5, for example. However, the Office Action fails to actually **resolve the level** of ordinary skill in the art. It is not enough to vaguely state "it would have been obvious to one with ordinary skill in the art."

Additionally, the Office Action does not attempt to explain a “reasonable expectation of success,” which is also a **required** factual finding under Rationale G.

For at least these reasons, the Office Action fails to provide all of the required factual findings with respect to Rationale G.

“[T]he Board cannot simply reach conclusions based on its own understanding or experience – or on its assessment of what would be basic knowledge or common sense. Rather, the Board must point to **some concrete evidence in the record in support of these findings**.”
See In re Zurko, 258 F.3d 1379, 1386 (Fed. Cir. 2001) (emphasis added).

For at least the reasons discussed in the Appeal Brief and above, the Applicants respectfully submit that the pending claims are allowable. Therefore, the Board is respectfully requested to reverse the rejections of pending claims 1-12, 14-26, 28-32, and 34-39.

The Commissioner is authorized to charge any necessary fees, or credit any overpayment to Deposit Account 13-0017.

Respectfully submitted,

Dated: April 5, 2011

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